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No. 552

In the

Supreme Court of the United States

OCTOBER TERM 1966

ZEGERS, INC.

Petitioner,

vs.

EDWARD A. ZEGERS

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

THOMAS F. MCWILLIAMS
53 West Jackson Boulevard
Chicago, Illinois 60604
Attorney for Petitioner

The Scheffer Press, Inc., 118 South Clinton Street, Chicago, Illinois

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Petitioner, Zegers, Inc., prays that a writ of certiorari issue to review that portion of the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above case on July 11, 1966, which affirmed the judgment of the District Court holding claims 5 and 6 of Zegers Patent No. 3,058,176 valid and infringed.

CITATIONS TO OPINIONS BELOW

The opinion of the District Court (App. 200) is unreported. It is included in the Appendix herein. The opinion of the Court of Appeals is not yet in the Federal

Second Series, but is reported at 150 U.S.P.Q. 409. The Court of Appeals opinion is included in the appendix herein.

JURISDICTION

The judgment of the Court of Appeals was entered on July 11, 1966. Rehearing was denied on August 16, 1966. The jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254(1).

QUESTIONS PRESENTED FOR REVIEW

This Court is requested to review the judgment of the Court of Appeals insofar as such judgment finds that claims 5 and 6 of United States Letters Patent No. 3,058,176 are valid and infringed by Petitioner because in such holding the Court of Appeals has construed Title 35 U. S. C. Sec. 103 in a manner in conflict with the recent decision of this Court in *William T. Graham et al.* v. *John Deere Co.* and *Calmar, Inc.* v. *Cook Chemical Company* (383 U. S. 1).

The facts in the instant case, under the recent decision of this Court, compel a holding that the subject matter of claims 5 and 6 of patent No. 3,058,176 would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said such subject matter pertained.

The invalidity of these claims is so clear that this Court should grant the writ and summarily reverse the judgment holding claims 5 and 6 valid.

STATUTES INVOLVED

35 U. S. C. 103—Conditions for patentability; non-obvious subject matter.

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

STATEMENT OF THE CASE

Edward A. Zegers filed a complaint charging Zegers, Inc. with infringement of patent No. 3,058,176. The case was heard by the District Court which entered a Memorandum Opinion (A. 200)* finding the claims in suit, claims 1, 3, 4, 5 and 6 valid and infringed. Pursuant to the Memorandum Opinion a judgment was entered (A214) finding claims 1, 3, 4, 5 and 6 valid and infringed by Zegers, Inc. Upon appeal, the Court of Appeals reversed the judgment of the trial court insofar as it held claims 1, 3 and 4 valid, and affirmed the judgment of the trial court holding claims 5 and 6 valid and infringed. It is only the holding of the Court of Appeals with respect to the validity and infringement of claims 5 and 6 to which this Petition is directed.

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* The Appendix in the Court of Appeals consisted of two volumes. Volume 1 containing the transcript of testimony will be referred to herein as (A ....). Volume 2, the Exhibit volume, will be referred to as (AE ....).

REASONS FOR THE ALLOWANCE OF THE WRIT

Zegers patent No. 3,058,176 (AE 1) is entitled MEANS FOR AND METHOD FOR DETACHABLY MOUNTING SASH GUIDE WEATHERSTRIPS IN WINDOW FRAMES. The subject matter of this patent is adequately described on page 3 of the Opinion of the Court of Appeals together with a reference to the illustrations appearing in the Appendix to the Opinion of the Court of Appeals. For ready reference with respect to the so-called invention of claims 5 and 6, we are inserting here duplicates of these illustrations, and in illustration B, we have colored red the asserted novel contribution of this patent as claimed by claims 5 and 6.

A. Illustrations taken from Zegers, Inc. patent No. 2,869,184 showing weatherstrip flexibly attachable to flat clip nailed on window frame, and flat nail-on clip.

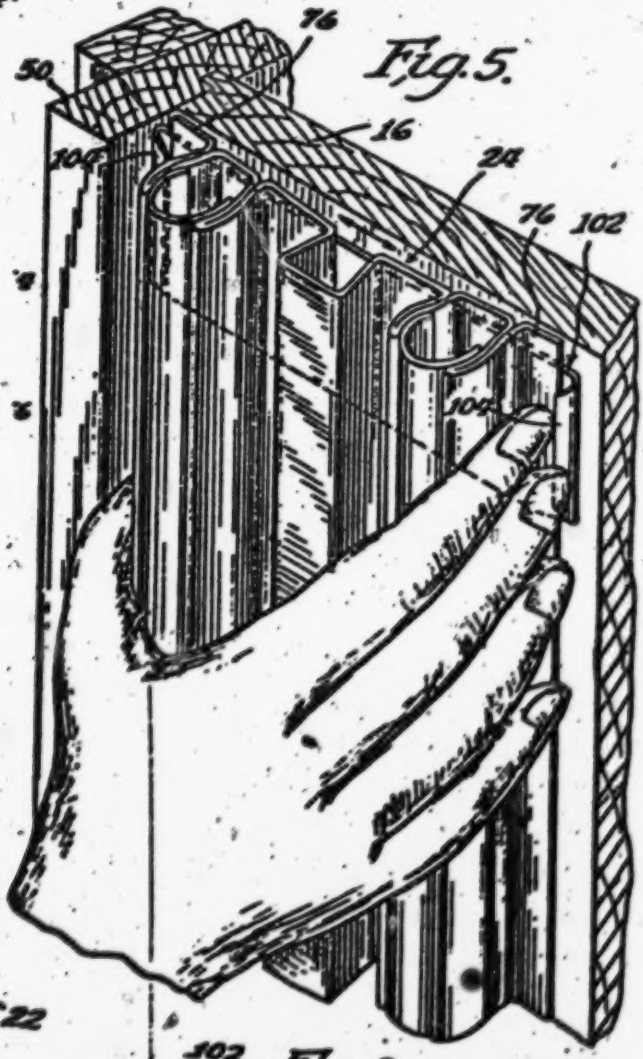


Fig. 5.



Fig. 8.

B. Illustration taken from Edward A. Zegers patent No. 3,058,176 showing slotted flanged weatherstrip, press-in clip, and portion of window frame with dado groove.

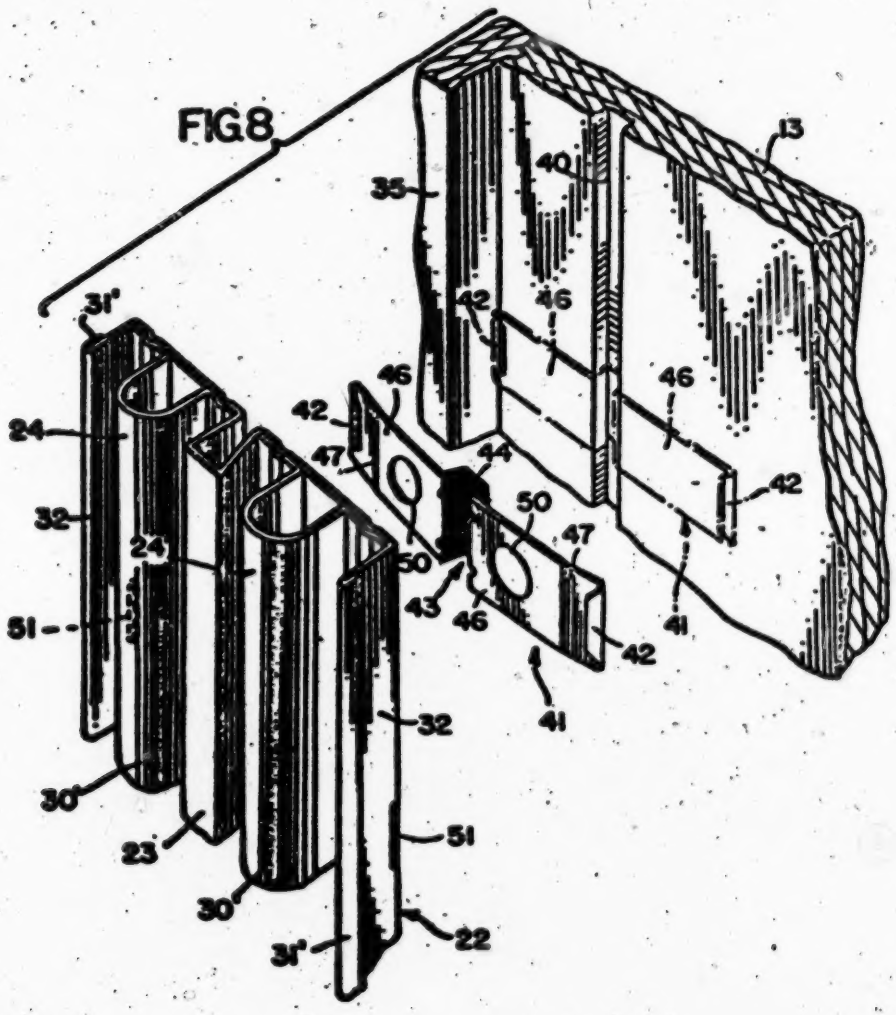


Illustration A shows the prior art patent No. 2,869,184 disclosing a weatherstrip flexibly attachable to a flat clip nailed on a window frame together with a flat nailed-on clip of the form shown in the bottom illustration, Figure 8. In use the flat clip is nailed to a window frame and the flexible weatherstrip member is flexed so that it may be positioned behind the hook portions and when released, the weatherstrip will expand to be releasably held behind these hook portions.

In illustration B from the drawings of the patent in suit, there is shown a clip pressed into a conventional slot or dado groove in a window frame member. The only asserted invention of claims 5 and 6 of the patent in suit is the concept of bending the flat clip of the earlier Zegers' patent to provide a recessed or channel portion and adding to it barbs extending outwardly from the side walls of the channel member whereby the clip may be pressed into the soft wood of the dado groove to be retained in place. This formation of the clip and its use permits a "press-in" installation as distinguished from the "nail-on" flat clip.

With respect to claims 5 and 6, the trial Court in its Memorandum Opinion stated:

> "Claims 5 and 6 concern an improvement upon the defendant's clip, Patent No. 2,869,184, described above, that allows the clip to be fastened on the window jamb without the need for supplemental fasteners, such as nails or staples. Prior to the defendant's invention of a clip for detachably mounting metal weatherstrip on a window jamb, the weatherstrip was nailed or stapled into place. The defendant's clip allows the weatherstrip to be detached, but the clip itself must be either nailed or stapled to the jamb." (A 210)

• • •

> "Plaintiff's invention takes advantage of the dado groove by pressing a clip into it. **The invention consists of* forming a clip, such as defendant's clip, by bending it to form a channel, shaped to fit into the dado groove. The channel portion has outwardly pressed teeth which engage the sides of the groove by biting into the wood.**" (A 210)

It is thus seen from the illustrations and the Opinion of the trial court that the only asserted novelty of the press-in clip of the patent in suit is the bending of the flat clip of the prior art Zegers patent No. 2,869,184 to form a channel portion with barbs therein to retain the clip in a groove in the window frame. (A 210).

In its Opinion concerning claims 5 and 6, the Court of Appeals stated:

> **"The second novel feature of the patent in suit, disclosed in claims 5 and 6, is the concept of bending the center portion of the clip to form a channel and adding metal barbs or outwardly-pressed teeth so that the clip may be manually pressed into a slot in the window jamb called a 'dado' groove, the teeth engaging the sides of the groove, thereby eliminating the necessity of nailing the clips in place."* (page 3)**

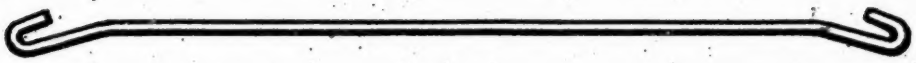
In its Opinion concerning the press-in feature (P. 7-9) the Court of Appeals concluded that the addition to the flat clip of the prior art of a channel portion having barbs therein for press-in insertion into a groove in a wooden frame member would not have been obvious to a person having ordinary skill in the art, and it is this conclusion of the Court of Appeals which is contrary to the holding of this Court in the *Graham* and *Calmar* cases.

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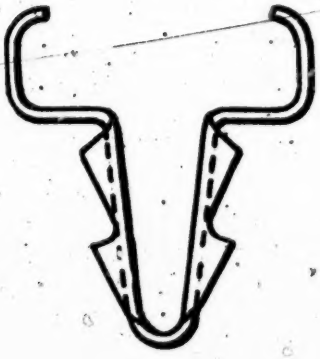
* Emphasis supplied.

The prior art which the Court of Appeals had before it includes Schuler patent No. 2,608,777 (AE 182) which shows that it was customary for purposes of supporting a member in a groove in a wooden frame member to have associated with the member to be supported, a rearwardly extending barbed member whereby, upon the application of pressure, the retaining member could be readily inserted into the slot with the barbs serving to hold the member therein. With this teaching it would have been obvious to anyone having ordinary skill in the art to take the flat clip of the prior art Zegers patent and form it with a rearwardly extending barbed member to secure the clip in a groove in a wooden frame member. The Schuler patent was not cited during the prosecution of the application for the patent in suit.

Another patent not cited by the Patent Office is the Conlon patent No. 2,219,382 (AE 158) which discloses a support member for a weatherstrip. The Conlon patent shows a hook member with a channel portion having barbs thereon for insertion into a slot wherein the barbs serve to anchor the weatherstrip supporting member in the slot. We are here inserting a drawing showing the flat clip of the prior art Zegers patent No. 2,869,184, the clip shown in the Conlon patent No. 2,219,382 and the clip claimed by claims 5 and 6 of the patent in suit. All of these clips relate to weatherstrip retaining members.



ZEGERS PAT. 2,869,184
JAN. 20, 1959



CONLON PAT. 2,219,382
OCT. 29, 1940.



ZEGERS PAT. 3,058,176
(PLAINTIFF'S DEVICE)
OCT. 16, 1962.

It certainly would have been obvious to anyone having ordinary skill in the art to take the flat clip of the Zegers patent No. 2,869,184, and apply the teachings of the Conlon patent to achieve the result of the press-in clip claimed by claims 5 and 6 of the patent in suit. The Patent Office in the prosecution of the application for the patent in suit did not consider the teachings of the Conlon patent and the existence of this patent was known to Edward A. Zegers during the prosecution of the application for the patent in suit, but he failed to call to the attention of the Patent Office the very pertinent Conlon patent.

Concerning the disclosure in the Conlon patent and of the clip shown in the attached drawing, Edward A. Zegers through his attorneys in earlier litigation compared the clip of the Conlon patent with the press-in clip of the patent in suit as being substantially identical. In a brief filed in the Court of Appeals for the 7th Circuit in No. 13310, Edward A. Zegers (Respondent here) stated at page 31:

> "The clip 10 shown in the Conlon patent is adapted to be mounted in an opening in the supporting member therefore (door jamb 5) however, note how much more closely it resembles the Defendant's 'press-in' clip* which was held to constitute an infringement of the patent in suit, than it does the clip disclosed in the patent in suit."

In a Reply Brief in No. 13310, Edward A. Zegers stated at page 8:

> "The Conlon patent discloses a clip for weatherstrip. It very closely resembles the Defendant's accused second form of clip.* It is fully capable

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* This is the clip claimed by claims 5 and 6.

of functioning in exactly the same manner to achieve exactly the same results."

The statement to the Court of Appeals in the earlier litigation (No. 13310), clearly establishes that Edward A. Zegers (Respondent here) fully agreed that there is substantial identity between the clip of the Conlon patent and the clip claimed by claims 5 and 6 of the patent in suit.

The issue is thus clearly drawn. Under title 35 U.S.C. Sec. 103 would it have been obvious to a person having ordinary skill in the art to bend the flat clip of the earlier Zegers patent to form a recess or channel portion with barbs therein so that the clip may be pressed into a slot in a wood frame member to hold it in place as distinguished from nailing the old flat clip in place?

In view of the Schuler patent referred to above and the Conlon patent which Respondent here conceded was substantially identical with the clip of claims 5 and 6, the conclusion is inescapable that claims 5 and 6 of the patent in suit (which claim only the addition of the channel barbed member to the old flat clip) claim subject matter which would have been obvious to a person having ordinary skill in the art.

The contribution by Edward A. Zegers, (Plaintiff, patent owner and Respondent herein), as claimed in claims 5 and 6 of the patent in suit, did not satisfy any long felt want. Edward A. Zegers testified:

"Q. Prior to that time, had anybody suggested to you the necessity of finding a better way to secure the clips to the wooden jamb unit.

"A. No, sir." (A 96)

Plaintiff-patent owner suggest that there were some difficulties with the earlier Zegers flat clip but stated:

> "Q. Did anybody ever raise any question with you that it was laborious to install, or time-consuming?
>
> "A. No." (A 97)

The judgment of the Court of Appeals holding claims 5 and 6 valid is erroneous in that the opinion is in conflict with the standard or criteria of obviousness set forth by this court.

In the *A & P* case (340 U.S. 147—1950) this Court stated:

> "The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans." (340 U.S. 152)

This language is applicable to the present situation where all the patentee did, as claimed in claims 5 and 6, was to duplicate substantially the Conlon clip or at most, to add the Conlon channel portion to the old flat clip of the prior art Zegers patent. Also, pertinent is the statement in the *A & P* case of Justice Douglas in the concurring opinion wherein he stated:

> "The patent involved in the present case belongs to this list of incredible patents which the Patent Office has spawned. The fact that a patent as flimsy and as spurious as this one has to be brought all the way to this Court to be declared invalid dramatically illustrates how far our patent system frequently departs from the constitutional standards which are supposed to govern." (340 U.S. 159).

In the *Graham* and *Calmer* cases (383 U.S. 1) this Court reaffirmed the *A & P* case and also approved the doctrine set forth in the *Hotchkiss case* (11 Howard 248). In Hotchkiss this Court stated:

> "Unless more ingenuity and skill . . . . were required than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of a skilled mechanic, not that of the inventor."

In the *Graham* and *Calmar* cases this court pointed out that the inquiry of the courts with respect to patentability must be beamed with greater intensity on the requirements of 103 and stated:

> ". . . it bears repeating that we find no change in the general strictness with which the overall test is to be applied."

The Court also pointed to the advanced technology, and that Courts should be aware of the changed conditions.

Concerning the patent involved in the *Graham* case, this Court in finding that the subject matter would have been obvious stated:

> "Certainly a person having ordinary skill in the prior art, given the fact that the flex in the shank could be utilized more effectively if allowed to run the entire length of the shank, would immediately see that the thing to do was what Graham did, *i.e.*, invert the shank and the hinge plate." (383 U.S. 25)

This language is pertinent to the present case. Certainly a person having ordinary skill in the prior art with the teachings of the Zegers prior art patent of a flat metal clip and with the teachings of the barbed

channel portion of the Conlon patent would immediately see that the thing to do, if the flat clip was desired to be pressed into a slot in a wooden frame member, would be to bend the flat clip to the shape of the clip of the Conlon patent. Such a solution is obvious.

With respect to claims 5 and 6 of the patent in suit, the Court of Appeals in its Judgment deviated from the strict standard announced by this Court in the *Graham* and *Calmar* cases. The application of the standard certainly should result in a holding of invalidity of claims 5 and 6 and failing to so hold the Court of Appeals is in conflict with the recent decision of this Court.

CONCLUSION

The situation is so clear in this regard that this Court might very well do what it did in the case of *Crest Specialty v. Trager,* 341 U.S. 912-913 wherein the Court granted the writ of certiorari and reversed the judgment holding the patent invalid solely on the *A & P* case.

For the purpose of having the judgment of the Seventh Circuit Court of Appeals reversed on its holding of validity of claims 5 and 6, and for the purpose of having such judgment conform to the standards set by this Court, in its interpretation of 35 U.S.C. Sec. 103, it is respectfully requested that this writ of certiorari be granted and that the judgment be reversed based upon this Court's holding in the *Graham* and *Calmar* cases.

Respectfully submitted,

THOMAS F. MCWILLIAMS
53 W. Jackson Boulevard
Chicago, Illinois 60204
Attorney for Petitioner.

APPENDIX A

Opinion of Court of Appeals

IN THE
UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

SEPTEMBER TERM, 1965 — APRIL SESSION, 1966

No. 15444

EDWARD A. ZEGERS,
Plaintiff-Appellee,
v.
ZEGERS, INC.,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

JULY 11, 1966

Before KNOCH, KILEY, and SWYGERT, *Circuit Judges.*

SWYGERT, *Circuit Judge.* Zegers, Inc., an Illinois corporation, appeals from a judgment of the district court in an action for patent infringement brought by Edward A. Zegers as the owner of United States Letters Patent No. 3,058,176, which issued October 16, 1962 on an application filed April 15, 1959. The district court held claims 1,3,4,5, and 6 valid and infringed by Zegers, Inc. and ordered an injunction and an accounting.[1] The principal questions presented relate to the alleged invalidity for obviousness, under 35 U.S.C. § 103, of two distinct and admittedly novel and useful features of the patent.

[1] The injunction and accounting were stayed pending this appeal.

In order to place the subject matter of the patent in suit in the proper context, the relationship of the parties and prior patent litigation between them will be discussed briefly. The plaintiff and the defendant are competitors in the sale of combination sash balance and weatherstrip units and clips for mounting such units in window frames. Edward A. Zegers was formerly employed by the defendant, Zegers, Inc., in which his brother Henry was the principal shareholder, but left that employment in 1955 and organized a competing operation.

In 1959 Zegers, Inc. brought suit against Edward A. Zegers, doing business as Precision Weatherstrip Company, for infringement of United States Letters Patent No. 2,869,184 owned by Zegers, Inc. The district court held the patent valid and infringed, and its decision was affirmed on appeal.[2] *Zegers, Inc. v. Zegers,* 299 F.2d 769 (7th Cir.), *cert. denied,* 369 U.S. 889 (1962). In that suit the inventive disclosure of the Zegers, Inc. patent was the concept of releasably or demountably securing combination sash balance and weatherstrip units to a window frame or jamb through the use of flat metal clips with hooked ends, nailed or stapled in place in the jamb, whereby metal weatherstrip could be readily attached to or removed from the window frame by flexing the weatherstrip to engage or disengage the hooked ends of the clip.[3] In the window structure claimed, four of these flat, hooked clips were secured to the jamb to receive a pair of the combination sash balance and weatherstrip units. The weatherstrip units themselves were elongated strips of resilient material with track means to guide the sash and with flat, laterally-extending or projecting side edges. The laterally-extending side edges were inserted into or removed from the hooked ends of the clips by the simple expedient of flexing the

[2] Edward A. Zegers is presently enjoined from any infringement of patent No. 2,869,184.

[3] See illustration in appendix.

units on their longitudinal axes to reduce their relative overall width. The clip device of the Zegers, Inc. patent effected great savings to millwork companies in the installation and maintenance of window units.[4]

> [I]t has become the general custom of millwork companies to deliver window units, complete with weatherstripping, to a job site. Prior to the invention of the patent in suit, these units were nailed into place. Thus there was no convenient way to remove the unit during painting, plastering or reglazing operations. Paint, plaster or varnish falling on the metal weatherstrip hindered its operation. When the units were nailed into place, removal required the use of tools and frequently damaged the light guage metal unit. These problems, in existence for many years, have been solved by the invention of the devices disclosed by the patent in suit. . . . 299 F.2d at 770.

The patent in suit relates to the same general subject matter as the earlier-litigated Zegers, Inc. patent. Patent No. 3,058,176, however, discloses two features not present in the Zegers, Inc. window structure.[5] The first feature, disclosed in claims 1, 3 and 4 of the patent, is the concept of using "flanged" weatherstrip units with clips and providing slots in the flanged units to receive the hooked ends of the clips.[6] Flanged weatherstrip is a commonly

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[4] In the earlier *Zegers* case we stated:

[5] See illustration in appendix.

[6] Claim 1 describes a flanged weatherstrip unit with a single slot to be received by the hook of a mounting clip. Claim 3 is identical to Claim 1 except for its reference to two slots, one at the base of each of two flanges in a weatherstrip unit, disposed to be received by the hooks of a mounting clip. Claim 4 identifies a combination of the flanged weatherstrip with slots and a mounting clip with hooks. None of these claims describes the type of mounting clip to be used with the slotted weatherstrip, except that the clip must have hooks.

used weatherstrip which differs from the weatherstrip used in connection with the clip of the earlier Zegers, Inc. patent only in that it has thin metal extensions (flanges) perpendicular to the jamb-overlying portion which serve as the outer guides in a channel to guide the sash. Ordinarily this type of weatherstrip could not be used with hooked-end clips. As stated by the district court, "The plaintiff's invention consists of slotting the junction of the flange and the jamb-overlying portion so that the hooks of the clip can fit over the metal lying on the jamb, in the same way that they fit over the thin metal edge of the other type of weatherstrip."

The second novel feature of the patent in suit, disclosed in claims 5 and 6, is the concept of bending the center portion of the clip to form a channel and adding metal barbs or outwardly-pressed teeth so that the clip may be manually pressed into a slot in the window jamb called a "dado" groove, the teeth engaging the sides of the groove, thereby eliminating the necessity of nailing the clips in place.[7] A dado groove is a small cut or slot in the center of the jamb running its entire length. Dado grooves have long been provided in window jambs to receive pieces of wood called "parting stops" which, among other things, serve to separate the sashes from each other. While dado grooves are unnecessary with metal weatherstrip, jambs are still generally provided with such grooves and the press-in feature of claims 5 and 6 takes advantage of them.

I. *The slotted-flange feature*

The novelty and utility of slotted flanged weatherstrip and the infringement of claims 1, 3, and 4, if valid, were conceded by Zegers, Inc. in the district court. The only issue presented was whether providing slots in flanged

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[7] Claims 5 and 6 are substantially alike. Neither claim describes the type of weatherstrip unit to be used with the clip except that it must have a lip to be received by the mounting clip.

weatherstrip to receive the hooks of clips secured to window frames would have been obvious to a person having ordinary skill in the art.

Both the hooked-end clips and flanged weatherstrip were old in the art. Flanged weatherstrip had been in use for many years; clips had been in use during the period between their conception and reduction to practice by Zegers, Inc. in early 1957 and Edward A. Zegers' idea of slotting the weatherstrip in January 1959. The evidence showed that Zegers, Inc. sold its flat nail-on clips for use with flangeless weatherstrip simultaneously with various lines of flanged weatherstrip (having the same general uses as flangeless weatherstrip) for approximately two years without discovering a method of using them together. The evidence further showed that on one occasion Zegers, Inc. had unsuccessfully attempted to mount flanged weatherstrip to a clip by using a type of clip which engaged the back of the weatherstrip unit.

On the other hand, testimony was introduced indicating that little or no interest in using flanged weatherstrip with the clip of the Zegers, Inc. patent had ever been expressed. In this connection, the actual conception of the idea of slotting flanged weatherstrip by Edward A. Zegers is illuminating. In January 1959 the plaintiff met at his plant with two customers of considerable experience in the millwork business and showed them a sample of his new press-in clip. The customers at that time were using flanged weatherstrip and had never seen clips for use with any kind of weatherstrip. When the plaintiff finished explaining his new clip to them, the customers remarked that it was a good idea, but that they could not use it because they were using, and preferred, flanged weatherstrip. The plaintiff's almost immediate rejoinder was that flanged weatherstrip could be adapted for use with his clip. He proceeded to prove his point by punching slots in a sample piece of flanged weatherstrip found in the shop and inserting the hooked ends of the clip into the slots.

The district court found that the defendant failed to satisfy its burden of presenting "clear and cogent" evidence of obviousness to rebut the presumption of validity of the patent. In addition, the district judge relied upon the fact that "no one had thought to use the clip with [flanged] weatherstrip until the plaintiff did so." We are of the view that slotting the flanged weatherstrip would have been obvious to anyone with ordinary skill in the art who had occasion to consider the possibility of using flanged weatherstrip with hooked-end clips and that therefore claims 1, 3, and 4 of the patent are invalid.

There is no doubt, as the plaintiff has reminded us, that the fact that the solution to a problem is simple, or appears so, when viewed in retrospect, does not mean the solution was obvious when it was made, and that courts must guard against the exercise of hindsight in assessing the obviousness of a given improvement in the art. *AMP Inc.* v. *Vaco Products Co.*, 280 F.2d 518 (7th Cir.), *cert. denied*, 364 U.S. 921 (1960); *Charles Peckat Mfg. Co.* v. *Jacobs*, 178 F.2d 794 (7th Cir. 1949), *cert. denied*, 339 U.S. 915 (1950). But at the same time, the application of section 103 in a manner consistent with rewarding only genuine contributions to the useful knowledge of an art requires that mere adaptions, arrangements, or manipulations be denied the grant of legal monopoly. If what has been created demonstrates no more ingenuity than the work of a mechanic skilled in the art, if the display of inventive capacity "involves only the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice," *Hollister* v. *Benedict & Burnham Mfg. Co.*, 113 U.S. 59, 73 (1885), then the product does not possess that "impalpable something" characterized as invention. *Great Atl. & Pac. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U.S. 147, 151 (1950).

The plaintiff contends that the decision of the district court should be affirmed because the defendant introduced

no proof that slotting the flanged weatherstrip was obvious. We think the simple juxtaposition of the prior art clip and flanged weatherstrip which were introduced into evidence disposes of this contention. It was not necessary to introduce evidence from the millwork art or any other art that slotting is a common mechanical means. It is true that the defendant did not think of slotting flanged weatherstrip, even though it sold such units simultaneously with its clips and in fact made an unsuccessful attempt to attach another type of clip to the back of its flanged weatherstrip. But these facts are not of themselves conclusive of non-obviousness, and it is also true, as the plaintiff testified, that no one suggested the desirability of using these items together until just prior to the time the problem was solved.

All that was done by the plaintiff-patentee was to provide slots, not totally unknown in themselves, in old flanged weatherstrip in order that the weatherstrip thus perforated might be received by the hooked end of a prior art clip. The suggestion that invention may reside in adding slots to prior art devices was commented upon by the Ninth Circuit in *Bergman* v. *Aluminum Lock Shingle Corp.*, 251 F.2d 801 (9th Cir. 1957). There the court stated:

> Twilight is falling upon "gadgets" as subjects of patents. The dusk commenced to gather half a dozen years ago when, in a epochal decision, [*Great Atl. & Pac. Tea Co.* v. *Supermarket Equip. Corp., supra*] the Supreme Court fixed its canon against dignifying combined "segments of prior art" with the title of "inventions."
>
> In a concurring opinion in that case, Mr. Justice Douglas compiled a devastating list of "gadgets" that have been placed "under the armour of patents." The specification at bar proclaims at the outset that it is a "drain slot which forms the basis of this invention." If the trivial devices listed by Mr. Justice Douglas are "gadgets," then, in the hierarchy of invention, a slot should be classified as a *sub*gadget. . . . *Id.* at 802.

Avoiding the temptation to make the unnecessary generalization that slotting, wherever found, is not invention, we

hold that adding slots to an existing device to permit it to be used in conjunction with hooks on another existing device involves no more than the "exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge," *Hollister* v. *Benedict & Burnham Mfg. Co., supra,* and was therefore obvious within the meaning of section 103.

II. *The press-in feature*

The novelty, utility, and infringement, if valid, of claims 5 and 6 embodying the press-in feature of the plaintiff's clip have also been conceded by Zegers, Inc. Thus the issue with respect to these claims is again restricted to obviousness, that is, whether the use of a press-in anchoring device containing barbed members for insertion into dado grooves to retain the clip therein without the use of any other fastening device would have been obvious to one with ordinary skill in the art.

The district judge found, as he had done with claims 1, 3, and 4, that the defendant failed to overcome the presumption of validity of claims 5 and 6 with sufficient evidence of obviousness and held the claims valid. In so finding, the district judge also concluded that the prior art patents relied on by the defendant were no more pertinent than those considered by the Patent Office and that therefore the presumption of validity had not been weakened. We think the disclosure of claims 5 and 6 stands on a different footing than the slotting of flanged weatherstrip, that it rises above the "gadget" category—in other words, that the record supports the district court's finding of validity.

The evidence tending to show the nonobviousness of recessing the center portion of the earlier Zegers, Inc. clip into the dado groove of a window frame and providing barbs in the recessed portion to engage the wooden sides of the dado groove thereby holding the clip securely in place was considerably stronger than that adduced in support of the nonobviousness of slotting flanged weatherstrip.[8]

[8] The burden of proving obviousness, of course, was on the defendant.

The plaintiff conceived his press-in clip and reduced it to practice early in 1959. The defendant did not place its version of the press-in feature on the market until three years later, during which time it admittedly experimented with many variations of its earlier flat nail-on clip, including some which incorporated barbed recessed members. Thus, even if the record does not disclose any substantial long-felt need for the press-in clip, the evidence does show that the defendant struggled with the solution to a problem already solved by the plaintiff.

As we have stated, the novelty and utility of the press-in feature were admitted. The plaintiff's clip affords a faster and easier means for mounting both flangeless and flanged weatherstrip in window frames than anything previously known in the art.[9] With it, weatherstrip units may be mounted without any tools whatsoever. A workman may either press the clip into the dado groove manually and then flexibly attach the weatherstrip unit, or he may mount the clip onto the weatherstrip unit, insert the unit into the window frame, and then press the clip into the groove. Despite the advantage thus gained by utilizing the otherwise useless dado groove, the evidence showed that for two years prior to the introduction of the press-in clip, many thousands of the defendant's flat clips were nailed directly across dado grooves during the installation of window units by workmen skilled in the art without ever appreciating the savings which could be made.

Finally, when the defendant did come out with a clip embodying the press-in feature of claims 5 and 6 of the plaintiff's patent, a clip which contains strikingly similar details and little else and which admittedly infringes these claims, the defendant obtained another patent for it.[10]

---

[9] The advance in the art in terms of savings in time and effort appears to us to be analogous to the advance credited to the introduction of the flat nail-on clip in the earlier Zegers litigation. See fn. 4, *supra*.

[10] United States Letters Patent No. 3,122,798, granted March 3, 1964 on an application filed April 11, 1962.

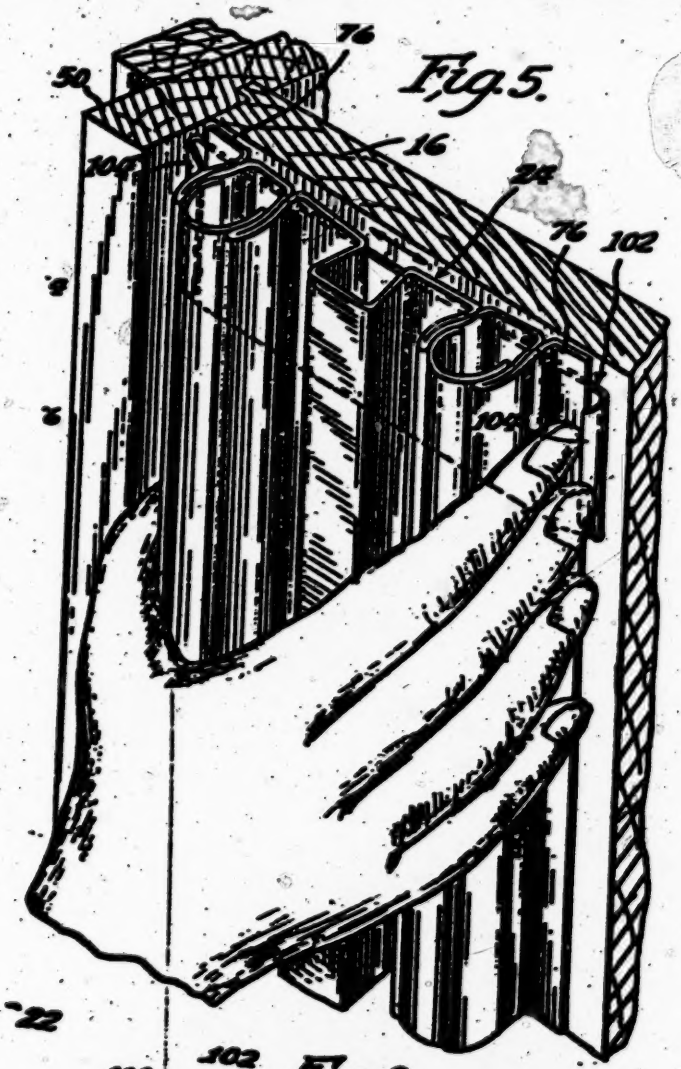
We have examined the prior art patents cited by the defendant and, with one exception, agree with the district court that the Patent Office did have equally relevant prior art before it in considering the plaintiff's application, and that the patents cited do not render the press-in clip obvious. The single exception is the Conlon patent, No. 2,219,382, which discloses a clip for mounting weatherstrip on automobile doors. The clip has hooked ends but is not used with detachably mounted weatherstrip. For that reason the Conlon patent was not particularly relevant to the clip in the earlier Zegers litigation, and we so stated. *Zegers, Inc.* v. *Zegers, supra* at 771. But the clip does have a recessed portion with two sets of jagged members which serve to hold it in place and therefore is quite pertinent to a consideration of the plaintiff's press-in clip in this case.[11] The Conlon patent, however, does not sufficiently suggest the teachings of the plaintiff's clip to deprive it of invention. As the district court stated: "Conlon is unlike the plaintiff's patent because the clip does not engage itself by biting into the sides of a channel, but fits through a slot in the sheet metal of the door after being compressed. This patent does not suggest shaping the clip to the channel and engaging it by using teeth to bite into the sides of the channel." Therefore, claims 5 and 6 of the patent in suit are valid and infringed by Zegers, Inc.

The judgment of the district court is affirmed in part and reversed in part and the case is remanded for proceedings consistent with the views expressed herein.

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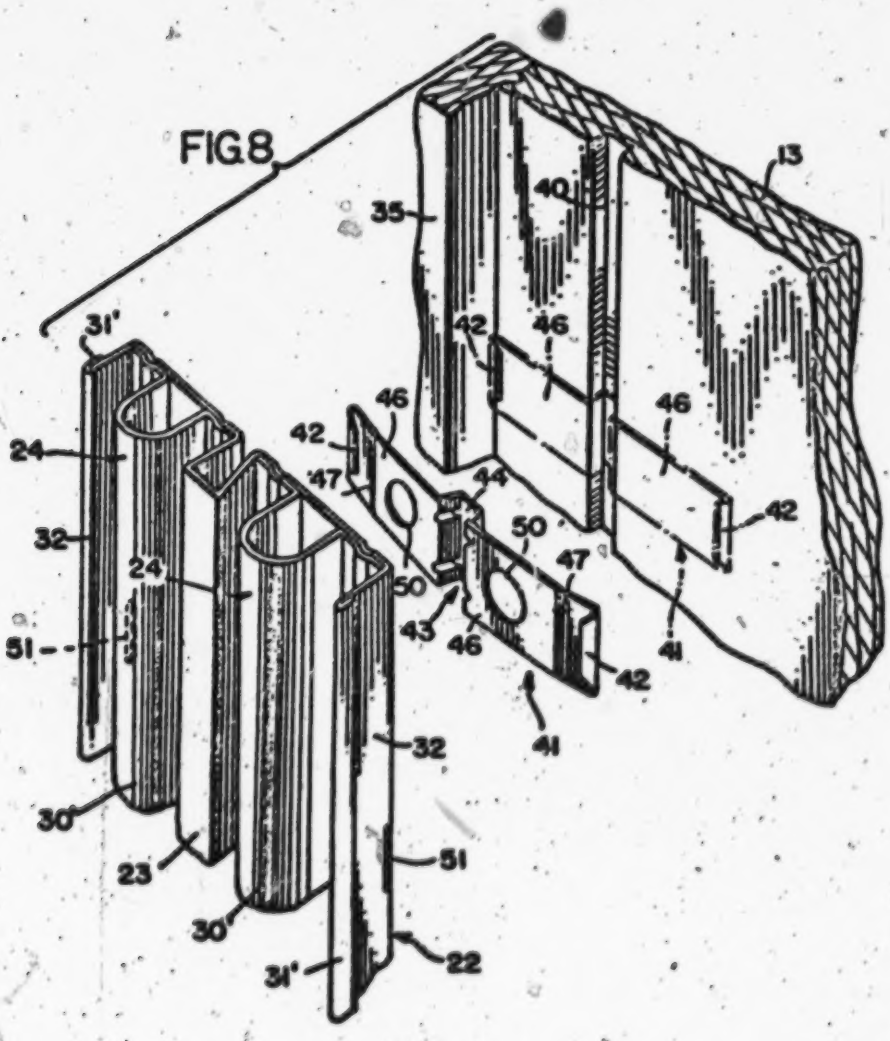
[11] The positions taken by both the plaintiff and the defendant in this case regarding the relevancy of the Conlon patent are inconsistent with their positions taken on other dates when their interests were different. In his brief before this court in the earlier *Zegers* case, the plaintiff (then defendant-appellant) told us that the Conlon clip was very much like his press-in clip. He stated, "It is fully capable of functioning in exactly the same manner to achieve exactly the same results." No. 13310, reply brief of defendant-appellant, p. 8. Similarly, in the prosecution of its application for patent No. 2,219,382, the defendant's version of a press-in clip, the defendant assured the Patent Office that the Conlon patent was not pertinent.

A. Illustrations taken from Zegers, Inc. patent No. 2,869,184 showing weatherstrip flexibly attachable to flat clip nailed on window frame, and flat nail-on clip.





B. Illustration taken from Edward A. Zegers patent No. 3,058,176 showing slotted flanged weatherstrip, press-in clip, and portion of window frame with dado groove.



APPENDIX B

Opinion of District Court

IN THE UNITED STATES DISTRICT COURT

• • (Caption—No. 63 C 1822) • •

MEMORANDUM OPINION
(Filed—Jul 14 1965)

This is a suit for the infringement of United States Patent No. 3,058,176, entitled "Means for and Method of Detachably Mounting Sash Guiding Weatherstrips in Window Frames." The patent was issued on October 16, 1962, to the plaintiff Edward A. Zegers.

Defendant, Zegers, Inc., is an Illinois corporation, engaged in the manufacture and sale of combination weatherstrip and sash balance units and clips for mounting such units in window frames.

Plaintiff was formerly employed by the defendant corporation but left in 1955, and is now a manufacturer's agent, competing with the defendant in the sale of the same type units and clips.

The plaintiff seeks an adjudication that Claims 1, 3, 4, 5 and 6 of his patent have been infringed by the defendant, an injunction and an accounting. The defendant alleges that the plaintiff's patent is invalid because the patent fails to be a sufficient advance over the prior art within the meaning of 35 U.S.C. § 103.

This Court has jurisdiction of the plaintiff's suit based upon the patent laws of the United States, 35 U.S.C. §§ 271 and 281 and 28 U.S.C. §1338.

A trial was held by the Court on the complaint of the plaintiff. This opinion is based upon the evidence adduced at three days of trial, as well as concise and informative briefs concerning the prior art.

The claims of the plaintiff's patent at issue in this suit are the following:

"1. For use in a window structure having a frame embodying a jamb, including a backstop, and a clip forming a weatherstrip mounting hook on the jamb, a weatherstrip of resilient sheet metal adapted to extend along the inwardly facing side of said jamb, in front of said backstop, said weatherstrip having a medial rib formed longitudinally thereof in position to project from the jamb, as a parting stop, and longitudinally extending jamb-overlying portions disposed on opposite sides of said rib, the rib remote edge of a said portion being formed to extend at and along said backstop in engagement therewith, the rib remote edge of the other of said portions being formed to extend on the side of said rib remote from said backstop, and being provided with an integral flange in position to project outwardly of the jamb in spaced parallel relation with respect to said rib, to form a sash receiving channel between said rib and said flange, said weatherstrip being formed with a slot at the junction of said flange with said jamb-overlying portion, in position to detachably receive the hook of a mounting clip secured on the jamb, whereby to secure the weatherstrip demountably in the frame."

* * *

"3. For use in a window structure having a frame embodying a jamb, including a backstop, and a clip forming a weatherstrip mounting hook on the jamb, a weatherstrip of resilient sheet metal adapted to extend along the inwardly facing side of said jamb, in front of said backstop, said weatherstrip having a medial rib formed longitudinally thereof in position to project from the jamb, as a parting stop, and longitudinally extending jamb-overlying portions disposed on opposite sides of said rib, the rib remote edge of a said portion being formed to extend at and along said backstop in engagement therewith, the rib remote edge of the other of said portions being

formed to extend on the side of said rib remote from said backstop, said remote edges each being provided with an integral flange in position to project outwardly of the jamb in spaced parallel relation with respect to said rib, to form sash receiving channels between said rib and said flanges, said weatherstrip being formed with a slot at the junction of each of said flanges with said jamb-overlying portion, said slots being each disposed in position to detachably receive the mounting hook of a cooperating mounting clip secured on the jamb, in registration with said slot, whereby to secure the weatherstrip demountably in the frame.

"4. The combination, with a window structure having a frame embodying a jamb, of a weatherstrip of resilient sheet metal extending along the inwardly facing side of said jamb, said weatherstrip having a medial rib formed longitudinally thereof in position to project from the jamb, as a parting stop, and longitudinally extending jamb-overlying portions disposed on opposite sides of said rib, the rib remote edges of said portions being provided with integral flanges in position to project outwardly of the jamb in spaced parallel relation with respect to said rib to form sash receiving channels on opposite sides of said rib and between it and said flanges, said weatherstrip being formed with transversely alined slots at the junction of said flanges with said jamb-overlying portions, and a mounting clip secured on the jamb and providing spaced apart hooks in position for detachable engagements in said slots, whereby to secure the weatherstrip demountably in the frame.

"5. In a window structure having a frame embodying a jamb formed with a longitudinal dado groove, a back stop extending along one side of the jamb and a sheet metal weatherstrip overlying the inner face of the jamb and providing a clip engaging lip at a side of the weatherstrip, and a clip for securing the weatherstrip upon the jamb in position extending

alongside of and abutting the back stop, said clip comprising an elongated strip of sheet metal having substantially greater length than width and bent to form a clip mounting portion embodying an open top channel having side walls spaced for snug frictional interfitment in the dado groove, said strip being formed with outwardly pressed teeth at the sides of said channel for biting engagement in the facing surfaces of the dado groove, said strip having an end portion spaced from said mounting portion in position to overlappingly engage said lip of the weatherstrip, to secure the weatherstrip on the jamb.

"6. In a window structure having a frame embodying a jamb formed with a longitudinal dado groove, a back stop extending along one side of the jamb and a sheet metal weatherstrip overlying the inner face of the jamb and providing a clip engaging lip at a side of the weatherstrip, and a clip for detachably securing the weatherstrip upon the jamb in position extending alongside of and abutting the back stop, said clip comprising an elongated strip of sheet metal having substantially greater length than width and bent to form an open top channel extending transversely across the strip and having a bottom and spaced side walls providing abutments for interfitting frictional engagement with the facing surfaces of the dado groove to mount the clip on the jamb, said strip being formed with outwardly pressed teeth, at the junction of the bottom wall with the side walls of the channel, for biting engagement in the facing surfaces of the dado groove, said strip having an end portion spaced from said channel in position to overlappingly engage said lip of the weatherstrip to secure the weatherstrip on the jamb."

It can be noted that Claims 1, 3 and 4 concern weatherstrip that can be detachably mounted in a window frame by means of a clip; Claims 5 and 6 concern a means for attaching the clip to the window jamb without the use of supplementary fasteners such as nails or staples.

To determine the state of the art at the time when the plaintiff made his alleged inventions, it is important to consider previous litigation between those parties. In Zegers, Inc. v. Zegers, 299 F. 2d 769 (7th Cir. 1962), cert. denied, 369 U.S. 889 (1962), the Court of Appeals affirmed a District Court decision holding the defendant's Patent No. 2,869,184, issued on January 20, 1959, valid and infringed by the plaintiff. The Court described the defendant's patent as follows:

> "The patent in suit is entitled 'Clip for Combination Weatherstrip and Sash Balance.' The subject matter relates to a combination sash balance and weatherstrip unit with clips to releasably secure sash balnce and weatherstrip units in place in a window frame unit. The clip is a flat piece of metal, with hook ends. Four clips, attached to a window frame or jamb, one each at top and bottom on each side, hold a conventional combination sash balance and weatherstrip unit removably in place. The combination unit, with its extending side edges, is flexed about its longitudinal axis to reduce the overall width of the unit to permit it to be placed flat against the frame behind the hook portions of the clip, or to be removed from them, by similar flexing. The clips may be nailed or stapled in place.
>
> "The District Judge found that it has become the general custom of millwork companies to deliver window units, complete with weatherstripping, to a job site. Prior to the invention of the patent in suit, these units were nailed into place. Thus there was no convenient way to remove the unit during painting, plastering or reglazing operations. Paint, plaster or varnish falling on the metal weatherstrip hindered its operation. When the units were nailed into place, removal required the use of tools and frequently damaged the light gauge metal unit. These problems, in existence for many years, have been solved by the invention of the devices disclosed by the patent in suit, a large number of which have been sold." 299 F. 2d 769, 769-70.

Claims 1, 3 and 4.

The patent in suit requires the examination of two kinds of weatherstrip. The defendant's patent was concerned with a kind of weatherstrip formed in such a manner that the outside edge along both sides of the entire weatherstrip was a thin metal projection of about one half an inch that was an extension of the jamb overlying portion of the weatherstrip. The Court of Appeals called this the extending side edge. The defendant's clips fit over the extending side edges on either side of the weatherstrip. The other type of weatherstrip commonly used is formed in such a manner that the outer edge of the weatherstrip is a flange, a thin piece of metal perpendicular to the jamb overlying piece, which is the outer guide for the sashes. Without modification, the flanged weatherstrip cannot be used with the defendant's clip because there is no projection of metal that the clip can grasp. The plaintiff's invention consists of slotting the junction of the flange and the jamb-overlying portion so that the hooks of the clip can fit over the metal lying on the jamb, in the same way that they fit over the thin metal edge of the other type of weatherstrip.

Specifically Claim 1 provides for fabricating flanged weatherstrip with a slot on only one side to receive the hook of a one hook mounting clamp; Claim 3 provides for fabricating flanged weatherstrip with two slots to receive both hooks of a two hook mounting clip, and Claim 4 provides for the combination of the flanged weatherstrip with the slot and the clip.

I have examined Claims 1, 3 and 4 in the light of 35 U.S.C. §§ 101 and 102 and find that the claims meet the requirements of these sections. The defendant does not contest this finding.

Whether these claims meet the other statutory requirement, unobviousness to a person of ordinary skill working in the art, is contested. 35 U.S.C. § 103 provides:

> "Conditions for patentability; non-obvious subject matter

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

According to one of the plaintiff's witnesses, a patent expert, the difference between the plaintiff's claims and the prior art lies in using a flanged weatherstrip with a clip. The flanged weatherstrip has been in use for many years, and the clip has been in use for several years; the clip had not previously been used with flanged weatherstrip. I have examined the evidence and find that the above testimony correctly indicated the extent of the advance over the prior art.

On the question of obviousness, the following evidence was presented:

(1) The defendant's vice president, a man skilled in the art, testified that the invention was obvious and that the only reason that it was not used earlier was because there was no demand for mounting flanged weatherstrip with a clip.

(2) There is testimony that two men who are employed in the millwork business, an industry that manfactures window frames and jambs, told the plaintiff that they would like to make use of the clip but could not because they wanted to use the flanged weatherstrip; neither of these men thought of slotting the weatherstrip. There is also evidence that when these men mentioned their desire to use the clip and their inability to do so, the plaintiff conceived the idea of slotting the weatherstrip without much deliberation.

(3) It appears that, prior to plaintiff's alleged invention, the defendant experimented with mounting flanged weatherstrip by means of a clip but was unsuccessful.

(4) It also appears that flanged weatherstrip has been in use for years and has the same uses as weatherstrip with extending side edges, described above. Although the defendant sold both kinds of weatherstrip, its president did not include the flanged weatherstrip in the previous patent for the clip issued to him. It would be as advantageous to use the flanged weatherstrip with the clip as it was to use the other kind of weatherstrip with the clip.

Since the burden of proof is on the defendant, the question is whether the defendant has presented the Court with "clear and cogent" evidence of obviousness so that it has carried its burden of proving invalidity.

In Copease Mfg. Co. v. American Photocopy Equipment Co., 298 F. 2d 772 (7th Cir. 1961), the Court said:

> "As in every patent case, there is here a presumption that the patent in suit is valid. The burden of establishing invalidity rests on defendants. 35 U.S.C.A. § 282. Helms Products v. Lake Shore Mfg. Co., 7 Cir., 227 F. 2d 677, 680.
>
> "This presumption is not an idle gesture, Artmoore Company v. Dayless Mfg. Company, 7 Cir., 208 F. 2d 1, 3, cert. denied 347 U.S. 920, 74 S. Ct. 518, 98 L. Ed. 1075, and is not to be overthrown except by clear and cogent evidence." 298 F. 2d 772, 777.

Considering all of the evidence before me, I find that the defendant has not sustained its burden of proof. The defendant's clip had been in existence for several years, and the two kinds of weatherstrip had been in use for many years prior to the plaintiff's invention. Even though the clip is as useful for flanged weatherstrip as it is for the weatherstrip with extending side edges, no one had thought to use the clip with the other weatherstrip until the plaintiff did so. That slotting the flange weatherstrip is simple does not negative the fact that slotting the flanged weatherstrip was not obvious to those skilled in the art. As Judge Duffy said in Amp Incorporated v. Vaco Products Co., 280 F. 2d 518 (7th Cir. 1960):

"Courts have rejected as a test of invention the apparent simplicity of an invention when viewed in retrospect. Diamond Rubber Company of New York v. Consolidated Rubber Tire Co., 220 U.S. 428, 31 S. Ct. 444, 55 L. Ed. 527; Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 279, 64 S. Ct. 598, 88 L. Ed. 721. In Charles Peckat Mfg. Co. v. Jacobs, 7 Cir., 178 F. 2d 794, 801, this Court said: 'That Peckat's device now seems comparatively simple, of course, is no criterion of his invention. "The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to anyone familiar with the subject; but the decisive answer is that with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before. The practiced eye of an ordinary mechanic may be sufficiently trusted to see what ought to be apparent to everyone." (Citing cases)' " 280 F. 2d 518, 521.

Regarding Claim 4 of the patent, the defendant argues that this claim is merely an aggregation of old, known art; therefore, the defendant continues, the claim is within the doctrine of Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U.S. 545 (1938), and is invalid. On the other hand, the plaintiff contends that the combination is not a mere aggregation but produces a new result. Church of Religious Science v. Kinkead Industries, Inc., 234 F. 2d 573 (7th Cir. 1956). I have found that the defendant has not proved that Claims 1 and 3 were obvious to one skilled in the art. Slotting, the subject of these claims, is the new element which has not been used before; thus the working together of the old weatherstrip, the old clip and the new slotting does form a combination and not an aggregation. For this reason I find that the defendant has not sustained its burden of proof as to Claim 4.

For the above reason, I hold that as a matter of law, Claims 1, 3 and 4 of the plaintiff's patent are valid.

The defendant has stipulated that if Claims 1, 3 and 4 were held valid, then they are infringed by the defendant.

Therefore, I hold that Claims 1, 3 and 4 of the plaintiff's patent have been infringed.

Claims 5 and 6.

Claims 5 and 6 concern an improvement upon the defendant's clip, Patent No. 2,869,184, described above, that allows the clip to be fastened on the window jamb without the need for supplemental fasteners, such as nails or staples. Prior to the defendant's invention of a clip for detachably mounting metal weatherstrip on a window jamb, the weatherstrip was nailed or stapled into place. The defendant's clip allows the weatherstrip to be detached, but the clip itself must be either nailed or stapled to the jamb.

Before the use of metal weatherstrip, a piece of wood called the parting stop was mounted in the jamb; it was used to separate the sashes from each other and to form the inside edge of the track on which the sashes move vertically. The parting stop fits into a dado groove which is about ½ an inch wide and ¼ an inch deep cut the entire length of the jamb at its center. The metal weatherstrip provides the parting stop by forming it out of metal. With a metal weatherstrip, the dado groove is not necessary; in fact, the defendant's patent for its clip shows mounting the clip by nailing or stapling it into a jamb which does not have a dado groove. Although most sashes are mounted in metal weatherstrip at the present time, jambs are still made with dado grooves.

Plaintiff's invention takes advantage of the dado groove by pressing a clip into it. The invention consists of forming a clip, such as defendant's clip, by bending it to form a channel, shaped to fit into the dado groove. The channel portion has outwardly pressed teeth which engage the sides of the groove by biting into the wood.

The clip can be pressed into the groove with the fingers and is difficult to remove once inserted.

Although the patent does not mention this, it appears that a push-in type of clip is almost essential to using

the clip with slotted weatherstrip. For weatherstrip with extending side edges, the clip can be placed near each end with several inches tolerance; but for the slotted weatherstrip, the clip must be placed so that it engages the slots exactly. This could be done by measuring the distance of the slots from the top and the bottom of the jamb and then placing the clip; however, measuring and nailing would take too much time. If the push-in clip is first attached to the slotted weatherstrip and then the combination is placed on the jamb and pushed in, the clips are positioned exactly and the strip can be disengaged for replacement later. The push-in clip eliminates measuring.

I have examined the prior art, and I find that the push-in feature described in Claims 5 and 6 is novel and useful and has not been directly anticipated. I therefore find that the requirements of 35 U.S.C. §§ 101 and 102 have been satisfied.

The defendant argues that Claims 5 and 6 are invalid because they would have been obvious to one skilled in the art, 35 U.S.C. § 103. The defendant also argues that the statutory presumption of validity ought not to apply because the patent office did not have the most relevant prior art before it when it considered the patent; the defendant seeks to bring itself within the rule that states that the presumption of validity is lessened when pertinent prior art is not before the Patent Office. As the Court stated in Milton Manufacturing Co. v. Potter-Weil Corp., 327 F. 2d 437 (7th Cir. 1964):

> "While the statutory presumption of validity must be considered, this court has adhered to the proposition that the presumption is greatly weakened when prior art patents have not been cited or considered by the Patent Office." 327 F. 2d 437, 438.

Regarding the prior art, the plaintiff's expert witness testified that Hill Patent No. 1,435,233, Stirn Patent No. 2,214,939, and Olds Patent No. 2,439,162 are not more relevant than Malpass Patent No. 2,823,071, which was

cited by the examiner. I have examined these patents and am in agreement with the expert; I find that these citations are not more relevant than Malpass.

Regarding other prior art patents, the expert testified that Schuler Patent No. 2,608,777 and Wilson Patent No. 2,734,789 are not as close as Beil Patent No. 2,337,633, which was cited by the examiner; I have examined these patents and am in agreement with the expert. I find that these citations are less relevant than Beil.

The defendant also cites Conlon Patent No. 2,219,382, which the Court of Appeals distinguished in Zegers, Inc. v. Zegers, supra, in the following manner:

> "A third patent on which defendant places great reliance is Conlon Patent No. 2,219,382, which does disclose a clip for securing weatherstripping to an automobile door, but once the Conlon clip is in place, the weatherstripping cannot be readily removed." 299 F. 2d 769, 771.

From the above findings, I hold that the examiner did have the most pertinent prior art before him, and that, therefore the presumption of validity has not been weakened.

Although the statutory presumption of validity applies, I am still under the obligation of examining the prior art to determine that the conditions of 35 U.S.C. § 103 have been satisfied. Concerning obviousness, what would be obvious to one skilled in the art refers not to a specific person or to an average craftsman but to a, more or less, hypothetical craftsman skilled in the art, that is, one who had before him all of the applicable references concerning the prior art. Frank B. Killian & Co. v. Allied Latex Corp., 188 F. 2d 940, 942 (2d Cir. 1951), cert. denied 342 U.S. 861 (1951). Because the statute refers to skilled craftsman in the art, prior art references dealing with the specific area of the patent window frames and the mounting of windows in frames, are the most relevant. Patents pertain-

ing to other arts are of interest, but they cannot be given as much weight.

The defendant cites Hill and Stirn as examples of the use of teeth on a metal piece attached to a wooden dowel that is inserted into a hole made for that purpose; the barbs are forced into the wood surrounding the opening so that the member is locked into place. These patents are removed from the art in question and do not immediately suggest the use of teeth to engage a clip on the two sides of a channel.

Conlon, Patent No. 2,219,382, discloses a clip for mounting weatherstripping on the edge of an automobile door. Conlon is unlike the plaintiff's patent because the clip does not engage itself by biting into the sides of a channel, but fits through a slot in the sheet metal of the door after being compressed. This patent does not suggest shaping the clip to the channel and engaging it by using teeth to bite into the sides of the channel. Furthermore, although, as the defendant points out, the clip is utilized to hold weatherstripping in a fashion similar to the plaintiff's Claims 5 and 6, the use of this clip is quite different because the strip is not mounted detachably.

The defendant also cites King, Patent No. 2,329,471, and Olds, Patent No. 2,493,162. Neither of these patents involves the relevant art and both require driving the metal insert into a hole or groove, spreading the metal by the pressure of the hammering. Plaintiff's patent depends upon the resiliency of the metal and is inserted by merely pushing.

None of the other patents relied upon directly suggest the plaintiff's invention.

For the above reasons, I find that the defendant has not overcome the statutory burden of proving the patent to be obvious and, therefore, invalid. I hold that Claims 5 and 6 of the plaintiff's patent are valid.

The defendant has conceded that if Claims 5 and 6 of the plaintiff's patent are held valid, then the press-in clip manufactured by it, as shown in Patent No. 3,122,798 owned by the defendant, infringes the plaintiff's patent. I, therefore, find that the defendant has infringed Claims 5 and 6 of the plaintiff's patent.

Plaintiff is entitled to the relief prayed for in his complaint. Plaintiff's counsel will prepare and submit a proposed judgment order within twenty days.

Enter:

/s/ Bernard M. Decker
United States District Judge.

Dated: July 14, 1965.

Office-Supreme Court, U.S.
FILED
OCT 6 1966
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1966.

No. 552

ZEGERS, INC.,

Petitioner,

vs.

EDWARD A. ZEGERS,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

DANIEL V. O'KEEFFE,
135 S. La Salle St.,
Chicago, Illinois 60603,
Attorney for Respondent.

THE GUNTHORP-WARREN PRINTING COMPANY, CHICAGO

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IN THE

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ZEGERS, INC.,

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EDWARD A. ZEGERS,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Respondent, Edward A. Zegers, plaintiff in the patent infringement suit in the District Court, opposes the petition for a writ of certiorari to review that portion of the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above entitled case on July 11, 1966, affirming the judgment of the District Court holding claims 5 and 6 of Zegers Patent No. 3,058,176 as valid and infringed.

JURISDICTION.

None of the grounds on which petitioner attempts to invoke jurisdiction of this Court is sufficient because:

(1) This case presents nothing more than the usual patent infringement case.

(2) There is no conflict between the decision of the Court of Appeals for the Seventh Circuit in this case and the decisions of this Court cited by the petitioner.

QUESTIONS PRESENTED.

Petitioner incorrectly states that the holding of the Court of Appeals that claims 5 and 6 of the patent in suit are valid and infringed is in conflict with the decision of this Court in *Graham et al.* v. *John Deere Co.* and *Calmar, Inc.* v. *Cook Chemical Co.*, 383 U. S. 1. It is not.

Petitioner incorrectly states that the facts in this case compel a holding that the subject matter of claims 5 and 6 would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertained (35 U. S. C. 103). The opinions of both the District Court and the Court of Appeals show that both courts carefully considered the facts in this case and the standard of patentability as provided by 35 U. S. C. 103, and properly decided this question contrary to this contention of the petitioner.

The petitioner incorrectly states that the invalidity of claims 5 and 6 is so clear that this Court should grant the writ and summarily reverse the judgment holding these claims valid and infringed. There is no basis in fact or in law for this statement of petitioner.

STATEMENT OF THE CASE.

Petitioner's statement of the case is incomplete in that it fails to point out that:

(1) The petitioner admitted novelty and utility of claims 5 and 6.

(2) The petitioner admitted infringement of claims 5 and 6, if those claims were valid.

(3) The petitioner had previously patented (Wm. Zegers Patent N. 2,869,184, EA-8) and sold a flat clip for mounting combination weatherstrip and sash balance units in window frames. This clip had to be nailed or stapled to the frame. When the petitioner adopted its admittedly infringing press-in clip, it took over 80 to 85% of the petitioner's total clip market substantially immediately (A-71).

(4) Dado grooves are provided in most window frames. When the respondent conceived and reduced to practice his patented press-in clip (which could be mounted in a dado groove) many thousands of the flat nail-on clips of the petitioner had previously been nailed across such dado grooves by workmen skilled in the art without their appreciating that a press-in clip could be provided. The petitioner did not come on the market with its admittedly infringing press-in clip until three years after respondent had conceived and marketed his press-in clip; and this was after the petitioner had admittedly unsuccessfully attempted to provide a press-in clip. With respect to these matters the Court of Appeals stated (PA-9a*):

> "The plaintiff conceived his press-in clip and reduced it to practice early in 1959. The defendant did not place its version of the press-in feature on the market until three years later, during which time it admittedly experimented with many variations of its earlier flat nail-on clip, including some which incorporated barbed recessed members. Thus, even if the record does not disclose any substantial long-felt need for the press-in clip, the evidence does show that the defendant struggled with the solution to a problem already solved by the plaintiff.

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* The pages of the opinion of the District Court and Court of Appeals appearing at the back of the Petition are referred to as (PA- .....).

"As we have stated, the novelty and utility of the press-in feature were admitted. The plaintiff's clip affords a faster and easier means for mounting both flangeless and flanged weatherstrip in window frames than anything previously known in the art. With it, weatherstrip units may be mounted without any tools whatsoever. A workman may either press the clip into the dado groove manually and then flexibly attach the weatherstrip unit, or he may mount the clip onto the weatherstrip unit, insert the unit into the window frame, and then press the clip into the groove. Despite the advantage thus gained by utilizing the otherwise useless dado groove, the evidence showed that for two years prior to the introduction of the press-in clip, many thousands of the defendant's flat clips were nailed directly across dado grooves during the installation of window units by workmen skilled in the art without ever appreciating the savings which could be made."

(5) The admittedly infringing clip of the petitioner embodies all of the details of construction of the plaintiff's patented clip, and merely adds some tongues thereto in the form of runners. Such tongues were shown to be useless at the trial (A. 44-48, 88-89). The petitioner obtained a patent on its admittedly infringing press-in clip (Wm. Zegers Patent No. 3,122,798, PX-15, EA-14). With respect to these matters the Court of Appeals stated as follows (PA-9a):

"Finally, when the defendant did come out with a clip embodying the press-in feature of claims 5 and 6 of the plaintiff's patent, a clip which contains strikingly similar details and little else and which admittedly infringes these claims, the defendant obtained another patent for it."[10]

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10. "United States Letters Patent No. 3,122,798, granted March 3, 1964 on an application filed April 11, 1962."

REASONS FOR NOT GRANTING THE WRIT.

1. This is an ordinary patent infringement suit with the petitioner merely asking this Court to review, de novo, the fact finding of both the District Court and the Court of Appeals. This is the only infringement suit filed on the aforementioned patent and, therefore, there is no conflict between decisions of various circuits.

2. The claimed conflict with decisions of this Court does not exist:

The petitioner suggests that the District Court, and the Court of Appeals, in holding claims 5 and 6 of the patent in suit valid, have deviated from the standard of patentability set forth by this Court in the cases of *Graham* v. *John Deere Co.* and *Calmar, Inc.* v. *Cook Chemical Co.*, 383 U. S. 1, 15 L. ed. 2d 545. This is erroneous.

With respect to the standards of patentability, this Court in the aforementioned *Graham* and *Calmar* cases stated (p. 553):

> "The Act sets out the conditions of patentability in three sections. An analysis of the structure of these three sections indicates that patentability is dependent upon three explicit conditions: novelty and utility as articulated and defined in § 101, and § 102, and nonobviousness, the new statutory formulation, as set out in § 103."

The petitioner admitted, and both the trial court and appellate court found, novelty and utility with respect to the subject matter of claims 5 and 6. Therefore, the only question with respect to patentability was that of "obviousness" under 35 U. S. C. 103.

With respect to the test of "obviousness" under the 1952 Patent Act, this Court in the aforementioned *Graham* and *Calmar* cases stated (p. 549):

> "We have concluded that the 1952 Act was intended to codify judicial precedents embracing the principle long ago announced by this Court in *Hotchkiss* v. *Greenwood*, 11 How. 248, 13 L. ed. 683 (1850), and that, while the clear language of § 103 places emphasis on an inquiry into obviousness, *the general level of innovation necessary to sustain patentability remains the same.*"*

As this Court stated in the aforementioned *Graham* and *Calmar* cases (p. 553), the test set forth in the aforementioned *Hotchkiss* case was whether

> "more ingenuity and skill . . . were required than were possessed by an ordinary mechanic acquainted with the business."

That this test was recognized and very carefully applied by the District Court with respect to the question of non-obviousness (35 U. S. C. 103) is clearly shown by the opinion of that Court (PA-24a-25a), the court stating (PA-24a):

> "Although the statutory presumption of validity applies, *I am still under the obligation of examining the prior art to determine that the conditions of 35 U. S. C. § 103 have been satisfied. Concerning obviousness, what would be obvious to one skilled in the art refers not to a specific person or to an average craftsman but to a, more or less, hypothetical craftsman skilled in the art, that is, one who had before him all of the applicable references concerning the prior art.*"

It is also clear from the opinion of the Court of Appeals (PA-1a, and 8a-10a) that the appellate court clearly recognized the proper standard to be applied, and carefully applied that standard.

3. The two prior art patents (Schuler 2,608,777, DX-10, EA-182; and Conlon 2,219,382, DX-5, EA-158) now relied

* Emphasis added through this brief unless otherwise indicated.

upon by the petitioner are not pertinent. Also, they were both carefully considered and rejected by the District Court and the Court of Appeals.

The Schuler patent is in the far-removed field of a price tag holder for use on the front edge of a store shelf. It discloses a molding having a longitudinally extending flange which may be driven into a shelf edge. The subject matter of this patent is far removed from that of claims 5 and 6 of the patent in suit, and this patent does not disclose or suggest a clip for mounting a weatherstrip unit in a window frame as defined in claims 5 and 6. As the uncontroverted testimony of respondent's expert witness shows (A. 185-187, 194-199) this patent is not as good a reference as the Beil patent No. 2,337,633 (EA-113), Goellner patent 2,275,-955 (EA-162), or Kunkel patent 2,865,061 (EA-140) considered and rejected by the Patent Office. Both the District Court (PA-24a) and the Court of Appeals (PA-10a) carefully considered and properly rejected this patent, as no more pertinent than the patents considered and rejected by the Patent Office.

The Conlon patent discloses a clip for mounting weatherstripping on the edge of an automobile door. The Conlon clip embodies a plurality of cams for progressively closing the clip as it is inserted into a complimentary shaped hole formed in the metal of an automobile door. It is not adapted to be, or intended to be, mounted in a dado groove of a window frame, as is the plaintiff's novel clip. The Conlon clip does not have the same construction as the plaintiff's press-in clip as defined in claims 5 and 6 and once the Conlon clip is installed, the weatherstrip is not readily removable therefrom. The Conlon patent does not disclose or suggest a clip for demountably mounting a weatherstrip unit in a window frame, as defined in claims 5

and 6. Both the District Court (PA-25a) and the Court of Appeals (PA-10a) carefully considered the Conlon patent and obviously were correct in their rejection thereof.

4. Petitioner suggests that respondent in a brief in earlier litigation between the same parties contended that the Conlon patent shows the patentable combination claimed in the claims in suit. This is in error. Furthermore, it is immaterial what the respondent's contentions might have been in the earlier litigation with respect to the Conlon patent, because both the District Court and the Court of Appeals in the earlier litigation, overruled the present respondent's contentions and adopted those of the present petitioner.

5. Also, with respect to the Conlon patent, petitioner fails to point out that:

a. In its brief in the aforementioned earlier litigation, the present petitioner stated (p. 33):

> "The next patent relied upon by Appellant is Conlon Patent No. 2,219,382 (App. 501), which discloses a weatherstrip unit for an automobile door. Appellant refers specifically to Figs. 5, 6, 7 and 8, of this patent and an examination of these figures will disclose wherein the Conlon device fails completely to achieve the results of the invention of the patent in suit. Fig. 5 of Conlon shows a clip. In Fig. 6, it is seen that the clip is inserted part way. *In Fig. 7., the rubber weatherstrip is being inserted by flexing the hook portions of the Conlon clip.* When the block portion of the rubber strip is secured in place in the clip, the clip is then pushed inwardly, reducing the distance between the ends of the hook portions of the clip and effectively securing the block portion of the weatherstrip in place. *Once the clip is in its fully secured position as shown in Fig. 8, there is no way the weatherstrip unit may be readily removed.*"

b. In its opinion in that earlier case, the Court of Appeals stated (299 F. 2d 769) at page 771:

> "A third patent on which defendant places great reliance is Conlon Patent No. 2,219,382, which does disclose a clip for securing weatherstripping to an automobile door, but once the Conlon clip is in place, the weatherstripping cannot be readily removed."

6. Furthermore, the petitioner fails to point out anywhere in its petition that the position now taken by the petitioner with respect to the Conlon patent is **contrary to the position stated by petitioner to the Patent Office** during the prosecution of the application which matured into the William Zegers Patent No. 3,122,798 (PX-15, EA-14) for the petitioner's *admittedly infringing* press-in clip. As shown by the file history (PX-15A, SA-22*) of that William Zegers patent, the petitioner assured the Patent Office as follows with respect to the Conlon patent (SA-35):

> "The *Conlon,* Starch, and Adams et al. Patents were all considered by the Court of Appeals in the above referred to *Zegers* v. *Zegers* case, and were found to be not pertinent to the clip device disclosed in Zegers patent 2,869,184. *It therefore necessarily follows that they are not pertinent to Applicant's clip device.*"

7. There is no basis in fact or in law for granting the petition for a writ of certiorari, or for summarily reversing the judgment of the Court of Appeals.

a. The case of *Crest Specialty* v. *Trager,* 341 U. S. 912, cited by the petitioner, is no authority for granting certiorari and summarily reversing the Court of Appeals, as requested by petitioner. The *Crest Specialty* case, of course, was decided upon its own facts. In that case, the petition for a writ of certiorari was

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* The Supplemental Appendix in the Court of Appeals is herein referred to as (SA .....).

granted and the case was put on the summary calendar. Thereafter, it was fully briefed and argued prior to the rendering of this Court's opinion.

b. Furthermore, the opinion of both the District Court (PA-15a) and the Court of Appeals (PA-1a) clearly show that both the Trial Court and the Appellate Court carefully considered the facts and carefully and properly applied the pertinent law thereto in determining that claims 5 and 6 were valid and infringed by the petitioner. Also, the facts in this case (many of which were not set forth by petitioner in its petition for certiorari, as previously pointed out herein, pp. 2-4) show that the respondent's invention, as claimed in claims 5 and 6, was anything but obvious, and that the District Court and the Court of Appeals were entirely correct in holding these claims valid.

CONCLUSION.

The decision of the Court of Appeals for the Seventh Circuit in this case is entirely correct. The grounds upon which the petitioner seeks certiorari herein are not well founded. The petition should be denied.

Respectfully submitted,

DANIEL V. O'KEEFFE,
135 South La Salle Street,
Chicago, Illinois 60603,
Attorney for Respondent.